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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,398	09/05/2003	Harald Bauer	2002DE131	7380
25255	7590	09/14/2005	EXAMINER	
CLARIANT CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 4000 MONROE ROAD CHARLOTTE, NC 28205			SZEKELY, PETER A	
			ART UNIT	PAPER NUMBER
			1714	
DATE MAILED: 09/14/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,398

Applicant(s)

BAUER ET AL.

Examiner

Peter Szekely

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 20-37, 39 and 41-44 is/are rejected.
- 7) ☒ Claim(s) 16-19 and 40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/8, 5/23, 3/24/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 3-6, 13, 25-26, 28-29, 31, 35 and 37-38 are rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 3-6 have no antecedent basis in claim 1. Claim 13 contains improper Markush language (zinc compounds). In claims 25-26 it is not defined what makes a mixer suitable for the claimed process. Claims 28-29 and 37-38 are indefinite because one of ordinary skill in the art would not know which additives could be used in the claimed composition, since anything added would be an additive. Claims 31 and 35 contain the indefinite word "type".

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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5. Claims 1-44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No. 10/890068. Although the conflicting claims are not identical, they are not patentably distinct from each other because the elastic covering material is a granule.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of copending Application No. 10/959,515. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed agglomerates are granules.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 8-15, 21, 22, 24, 27, 28, 31-37, 43 and 49 are rejected under 35 U.S.C. 102(b or e) as being anticipated by Ishikawa 4,107,376, Kleiner et al. 5,891,226 or Semen 6,515,052.

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9. Ishikawa discloses granulated fire retardants in the Title, sodium phosphate and metaphosphate in claim 8, minerals in claim 9, polyurethane in 13, particle size in column 7, line 25 and concentrations in column 8, lines 15-25. Kleiner et al. teach granulating and masterbatching fire retardant granules in column 3, lines 15-30, articles in column 3, lines 52-58, and polymers in claim 1. Semen recites granular additives in the Title, phosphorus containing flame retardants in claim 1, binders in claim 10 and other components from column 8, line 50, through column 9, line 55. Applicants' claims are not novel.

10. Claims 1, 7-15, 20-22, 24, 28, 30-34, 37, 39, 43 and 44 are rejected under 35 U.S.C. 102(b or e) as being anticipated by Noetzel et al. 3,980,614, Fuhr et al. 5,021,488, Sicken et al. 5,326,805, Gareiss et al. 6,084,012 or Bienmuller et al. 6,780,905.

11. Noetzel et al divulge flame retardant granules in column 3, lines 59-66 and Examples 8 and 9. Fuhr et al. reveal polyamide, phosphorus compounds, anti-drip agents, zinc borate and glass fiber being granulated in column 10, lines 59-65. Sicken et al. display ammonium polyphosphate, polyolefin and nitrogen containing flame-retardant in claim 1, masterbatching in claim 14 and granulating in the paragraph overlapping columns 8 and 9. Gareiss et al. present granulating in column 12, lines 61-65, red phosphorus, polymers and additives in claim 1 and other additives from column 11, line 60, through column 12, line 51. Bienmuller et al. describe granulating in column 13, lines 8-12 and ingredients in Table 1, claims 1-10 and columns 11 and 12. Applicants' claims are not novel.

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12. Claims 1-7, 9, 11, 14, 15, 21, 24, 27, 28, 30-35, 37, 43 and 44 are rejected under 35 U.S.C. 102(e) as being anticipated by Jeneweine et al. 6,365,071.

13. Jeneweine et al. discuss granulating in column 7, lines 5-13, phosphinic salts and nitrogen containing compounds in claims 1-5, polymers in claim 6 and fillers in column 7, lines 23-25. Applicants' claims are not novel.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 1-15, 20-24, 27, 28, 30-37, 39 and 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noetzel et al. 3,980,614, Ishikawa 4,107,376, Fuhr et al. 5,021,488, Sicken et al, 5,326,805, Kleiner et al. 5,891,226, Gareiss et al, 6,084,0112, Jeneweine et al. 6,365,071, Semen 6,515,052 or Bienmuller e al. 6,780,905.

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17. All references have been discussed already. Although none of the references show a particle size of 2 mm-s or less, the examiner believes that granulates customarily have that particle size. The same goes for the bulk density. Furthermore, it would have been obvious to one having ordinary skill in the art; at the time the invention was made, to select applicants' ingredients from a list of equivalents.

Allowable Subject Matter

18. Claims 16-19 and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

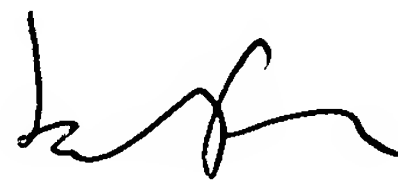
19. Claims 25, 26, 29 and 38 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (571) 272-1124. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Peter Szekely
Primary Examiner
Art Unit 1714

P.S.
8/15/05